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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,963	07/29/2003	Richard W. Nykamp	76764.(new)	6180

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,963

Applicant(s)

NYKAMP ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Withdrawn Rejections

1. The obviousness-type double patenting rejection of claims 17-19 over claims 8-10 of copending Application No. 09/999,400 of record in the previous Office Action mailed 5/12/06, Pages 3-4, Paragraph #5 has been withdrawn due to the Terminal Disclaimer filed 7/13/06.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Martinez (US 3,697,363).

Martinez discloses an article of office furniture comprising a metal office furniture piece (*Fig. 1*) including a plurality of components each having dimensions (*Fig. 1, elements 16, 16a and 16b*), and a plurality of magnetic decorative covers, each of the covers overlying and attached to one of the components (*Figs. 1 and 5, element 12*), each of the covers having dimensions substantially the same as the dimensions of the component to which the cover is attached (*Figs. 1 and 5, element 12*), each of the covers comprising a magnetic sheet (*see col. 3, lines 70-75*) and a decorative material such as veneer and a laminate (*see col. 3, lines 45-50 and col. 4, lines 1-7*).

Regarding the limitation “metal office furniture”, the Examiner has given the term the broadest reasonable interpretation consistent with the written description in applicant’s specification as it would be interpreted by one of ordinary skill in the art. See MPEP 2111. The Examiner has interpreted “metal office furniture” to mean furniture with any part that is metal. In this case, Martinez discloses the office furniture piece to include a metal part (*see col. 5, lines 5-11*) and therefore is considered metal office furniture.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez (US 3,697,363) in view of Barler et al. (US 2,438,108).

Regarding claim 17, Martinez discloses an article of office furniture comprising an office furniture piece (*Fig. 1*) including a plurality of components each having dimensions (*Fig. 1, elements 16, 16a and 16b*), and a plurality of magnetic decorative covers, each of the covers overlying and attached to one of the components (*Figs. 1 and 5, element 12*), each of the covers having dimensions substantially the same as the dimensions of the component to which the cover is attached (*Figs. 1 and 5, element 12*), each of the covers comprising a magnetic sheet (*see col. 3, lines 70-75*) and a decorative material such as veneer and a laminate (*see col. 3, lines 45-50 and col. 4, lines 1-7*). However, Martinez fails to teach the office furniture piece (cabinet) being

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made of metal. Although Martinez teaches metal plates being adhered on the components of the furniture piece (*see col. 5, lines 5-11*).

Barler et al. teaches that it is well-known in the art to have a cabinet made of metal and it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the cabinet in Martinez to be made of metal as suggested by Barler et al. in order to save the step and money of gluing metal plates onto the components of the furniture piece.

Regarding claim 19, Martinez further fails to disclose one of the decorative covers defining a cutout providing an aesthetic appearance such as a logo.

Modifications to an "ornamental device" are purely decorative changes and do not change the way the device is used or works. Therefore, to have the magnetic decorative cover define a cutout providing an aesthetic appearance such as a logo is an obvious matter of design choice because it is merely changing the aesthetic design and/or the shape of the "ornamental" device.

In general terms the distinction between design and utility patents are that a "utility patent" protects the way an article is used and works (35 U.S.C. 101) and a "design patent" protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. MPEP 1502.01.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified one of the magnetic decorative covers in Martinez to define a cutout providing an aesthetic appearance such as a logo, since it is an

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obvious matter of design choice because it is merely changing the aesthetic design and/or the shape of the “ornamental” device.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 17 above, and further in view of Vela (US 2001/0008702 A1).

Martinez and Barler et al. teach the presently claimed article of office furniture as detailed above. However, Martinez fails to teach the magnetic sheet being flexible.

Vela teaches a magnetic sheet being flexible for easy application and removal of a magnetic material decoration without additional means of support and without causing damage to the support surface (*see paragraph 0002*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the magnetic sheet of the decorative covers in Martinez to be flexible as suggested by Vela in order to have easy application and removal of the magnetic material decoration without additional means of support and without causing damage to the support surface (*see paragraph 0002*).

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez (US 3,697,363) in view of Vela (US 2001/0008702 A1).

Martinez teaches the presently claimed article of office furniture as detailed above. However, Martinez fails to teach the magnetic sheet being flexible.

Vela teaches a magnetic sheet being flexible for easy application and removal of a magnetic material decoration without additional means of support and without causing damage to the support surface (*see paragraph 0002*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the magnetic sheet of the decorative covers in Martinez to be flexible as suggested by Vela in order to have easy application and removal of the magnetic material decoration without additional means of support and without causing damage to the support surface (*see paragraph 0002*).

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al. (US 3,697,363).

Martinez teaches the presently claimed article of office furniture as detailed above. However, Martinez fails to disclose one of the decorative covers defining a cutout providing an aesthetic appearance such as a logo.

Modifications to an "ornamental device" are purely decorative changes and do not change the way the device is used or works. Therefore, to have the magnetic decorative cover define a cutout providing an aesthetic appearance such as a logo is an obvious matter of design choice because it is merely changing the aesthetic design and/or the shape of the "ornamental" device.

In general terms the distinction between design and utility patents are that a "utility patent" protects the way an article is used and works (35 U.S.C. 101) and a "design patent" protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. MPEP 1502.01.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified one of the magnetic decorative covers in

Martinez to define a cutout providing an aesthetic appearance such as a logo, since it is an obvious matter of design choice because it is merely changing the aesthetic design and/or the shape of the “ornamental” device.

9. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vela (US 2001/0008702 A1).

Regarding claims 17 and 18, Vela discloses an article of office furniture comprising a metal office furniture piece (file cabinet) including a plurality of components each having dimensions (*see paragraph 0013, line 8*); and a plurality of magnetic decorative covers wherein each of the covers are overlying and are attached to one of the components (*see paragraph 0020*) and each of the covers comprising a flexible magnetic sheet and a decorative material such as vinyl (*see paragraphs 0011 and 0013*).

However, Vela fails to disclose each of the covers having dimensions substantially the same as the dimensions of the component to which the cover is attached. Although Vela does teach the magnetic decorative covers being either die-cut or manually cut to the shape of the graphics, and the shape being die-cut for precise sizing and manually cut-to-shape based on desired graphics (*see paragraph 0019, lines 11-15*).

Modifications to an “ornamental device” are purely decorative changes and do not change the way the device is used or works. Therefore, to have the magnetic decorative covers have dimensions substantially the same as the dimensions of the component to which the cover is attached is an obvious matter of design choice because it is merely changing the aesthetic design and/or the shape of the “ornamental” device.

In general terms the distinction between design and utility patents are that a “utility patent” protects the way an article is used and works (35 U.S.C. 101) and a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. MPEP 1502.01.

It would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the magnetic decorative covers in Vela to have dimensions substantially the same as the dimensions of the component to which the cover is attached, since it has been held that a change in the shape or size of the covers would be an unpatentable modification in absence of showing unexpected results and it has been held to be within the general skill of a worker in the art to select a shape or size on the basis of its suitability for the intended use as a matter of obvious design choice. Furthermore, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the magnetic decorative covers in Vela to have dimensions substantially the same as the dimensions of the component to which the cover is attached in order to decorate that component of the furniture piece in entirety, if so desired.

Regarding claim 19, Vela further fails to teach the decorative cover defining a cutout providing an aesthetic appearance such as a logo.

Again, modifications to an “ornamental device” are purely decorative changes and do not change the way the device is used or works. Therefore, to have the magnetic decorative cover define a cutout providing an aesthetic appearance such as a logo is an obvious matter of design

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choice because it is merely changing the aesthetic design and/or the shape of the “ornamental” device.

In general terms the distinction between design and utility patents are that a “utility patent” protects the way an article is used and works (35 U.S.C. 101) and a “design patent” protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. MPEP 1502.01.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the magnetic decorative cover in Vela to define a cutout providing an aesthetic appearance such as a logo, since it is an obvious matter of design choice because it is merely changing the aesthetic design and/or the shape of the “ornamental” device.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Catherine A. Simone
Examiner
Art Unit 1772
September 30, 2006


ALICIA CHEVALIER
PRIMARY EXAMINER